



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/619,032

07/19/2000

Dennis Murphy

DIVER1120-3

2212

7590

11/30/2005

Morrison & Forester LLP  
3811 Valley Centre Drive  
Suite 500  
San Diego, CA 92130

EXAMINER

RAMIREZ, DELIA M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Response to Rule 312 Communication</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/619,032	MURPHY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Delia M. Ramirez	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

1. ☒ The amendment filed on 16 May 2005 under 37 CFR 1.312 has been considered, and has been:

a) ☐ entered.

b) ☒ entered as directed to matters of form not affecting the scope of the invention.

c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

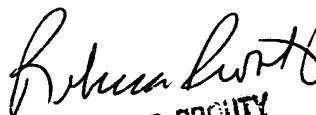
Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

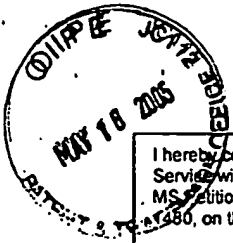
d) ☐ disapproved. See explanation below.

e) ☐ entered in part. See explanation below.

*In view of the papers filed 5/16/2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventor Dan E. Robertson.*

*The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.*

  
**REBECCA E. PRO CUTY**  
**PRIMARY EXAMINER**  
**GROUP 1800**  
 1600



I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 13, 2005

Signature:

*Norman Green*  
(Norman Green)

Docket No.: 564462000312 /  
004004 / D1120-3US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/619,032

Confirmation No.: 2212

Filed: July 19, 2000

Art Unit: 1652

For: ALPHA GALACTOSIDASES AND METHODS  
FOR MAKING AND USING THEM  
(AMENDED)

Examiner: Delia M. Ramirez, Ph.D.

**REQUEST FOR CORRECTION OF INVENTORSHIP**  
**PURSUANT TO 35 U.S.C. 116 & 37 C.F.R. § 1.48(a)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The presently named applicants hereby petition the Commissioner to amend the above captioned application to add the name of Dan E. ROBERTSON as joint inventor. Enclosed are the following:

1. A statement from each person being added as inventor that the error in inventorship occurred without deceptive intent on his/her part. Dan E. ROBERTSON is the only added inventor.
2. An oath or declaration by the actual inventor or inventors as required by § 1.63.
3. The written consent of the assignee, Diversa Corporation.

05/17/2005 MAHMED1 00000062 031952 09619032

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sd-259768

4. The fee set forth in 37 C.F.R. § 1.17(i) of \$130.00.

☐ is enclosed

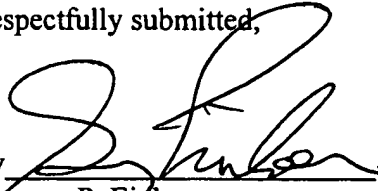
☒ is authorized to be charged to Deposit Account 03-1952. A Fee Transmittal (form PTO/SB/17i) is enclosed in duplicate for that purpose.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462000312.

It is believed that applicants have complied with requirements and correction of the inventorship in the present application is respectfully requested.

Dated: May 13, 2005

Respectfully submitted,

By 

Gregory P. Einhorn

Registration No.: 38,440  
MORRISON & FOERSTER LLP  
3811 Valley Centre Drive, Suite 500  
San Diego, California 92130  
(858) 720-5133



Docket No.: 564462000312 / 004004 / D1120-3US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/619,032

Confirmation No.: 2212

Filed: July 19, 2000

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS OF USING THEM (AMENDED) Examiner: D. Ramirez

**STATEMENT OF DAN E. ROBERTSON**  
**PURSUANT TO 37 C.F.R. § 1.48(a)(2)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Dan E. ROBERTSON, declare as follows:

1. I am a joint inventor of the above-referenced patent application, U.S. Application Serial No. 09/619,032, filing date July 19, 2000, and am familiar with the contents thereof.
2. The error of failing to include myself, Dan E. ROBERTSON, as a joint inventor of the patent application occurred without any deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4-29-05  
Date

  
Dan E. ROBERTSON



Attorney Docket No.: 564462000312 / 004004 / D1120-3US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**ALPHA-GALACTOSIDASES AND METHODS OF USING THEM (AMENDED)**

the specification of which was filed on July 19, 2000 as Application No. 09/619,032.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

**FOREIGN PRIORITY CLAIM**

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☒ no foreign applications have been filed

☐ foreign application have been filed as follows:

**EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing	Priority Claimed Under 35 USC 119
			___ Yes No ___
			___ Yes No ___
			___ Yes No ___

**ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing

**CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS**

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

☒ no U.S. provisional applications have been filed.

☐ U.S. provisional application have been filed as follows:

Application Number	Date of Filing	Priority Claimed Under 35 USC 119
		___ Yes No ___
		___ Yes No ___
		___ Yes No ___

**CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)**

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

☐ no U.S./PCT applications have been filed.

☒ U.S./PCT application have been filed as follows:

Application Number	Date of Filing	Status (Patented/Pending/Abandoned)
09/407,806	09/28/1999	Pending
08/613,220	03/08/1996	Patented

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 45975

all of **Morrison & Foerster LLP**, 3811 Valley Centre Drive, Suite 500, San Diego, California 92130-2332, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

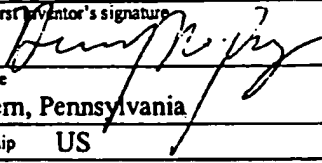
Please mail all correspondence to Gregory P. Einhorn, whose address is:

**Morrison & Foerster LLP**  
3811 Valley Centre Drive  
Suite 500  
San Diego, California 92130-2332

Please direct telephone calls to: Gregory P. Einhorn at (858) 720-5133.

Please direct facsimiles to: (858) 720-5125



Full name of sole or first inventor <b>Dennis MURPHY</b>	
Sole or first inventor's signature 	Date <b>Mar 10 2002</b>
Residence <b>Malvern, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>1320 Eaves Spring Road Malvern, Pennsylvania 19355</b>	

Full name of second inventor, if any <b>John REID</b>	
Second inventor's signature	Date
Residence <b>Ardmore, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>44 St. Paul's Road Ardmore, Pennsylvania 19003</b>	

Full name of third inventor, if any <b>Dan E. ROBERTSON</b>	
Third inventor's signature	Date
Residence <b>San Diego, California</b>	
Citizenship <b>US</b>	
Mailing Address  <b>6332 Oleander Way San Diego, California 92130</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Mailing Address	

Full name of sole or first inventor <b>Dennis MURPHY</b>	
Sole or first inventor's signature	Date
Residence <b>Malvern, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>1320 Eaves Spring Road Malvern, Pennsylvania 19355</b>	

Full name of second inventor, if any <b>John REID</b>	
Second inventor's signature <i>John Reid</i>	Date <b>13 Apr 2005</b>
Residence <b>Ardmore, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>44 St. Paul's Road Ardmore, Pennsylvania 19003</b>	

Full name of third inventor, if any <b>Dan E. ROBERTSON</b>	
Third inventor's signature <i>Dan E. Robertson</i>	Date <b>4-29-05</b>
Residence <b>San Diego, California</b>	
Citizenship <b>US</b>	
Mailing Address  <b>6332 Oleander Way San Diego, California 92130</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Mailing Address	



Docket No.: 564462000312 / 004004 / D1120-3US  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
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Application No.: 09/619,032

Confirmation No.: 2212

Filed: July 19, 2000

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS OF USING THEM (AMENDED) Examiner: D. Ramirez

**CONSENT OF ASSIGNEE UNDER 37 C.F.R. § 3.73(b) AND 37 C.F.R. § 1.48(a)(5)**  
**TO CORRECT INVENTORSHIP**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Diversa Corporation is the assignee of the entire right, title and interest in the invention claimed in the above captioned U.S patent application 09/619,032 by virtue of an assignment recorded by the U.S. Patent and Trademark Office on March 8, 1996, with Reel 7949 and Frame 0419. The undersigned, who is authorized to execute this Consent on behalf of Diversa Corporation, states that Diversa Corporation consents to the correction of inventorship to add Dan E. ROBERTSON as co-inventor.

Executed on APRIL 29, 2005, at San Diego, California

Signature: Carolyn Erickson

Printed Name: Carolyn Erickson

Title: Vice President, Intellectual Property